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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,715	02/25/2002	Francis M. Creighton	5236-000313	5857

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EXAMINER	
DONOVAN, LINCOLN D	
ART UNIT	PAPER NUMBER

2832

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>10/082,715</b>	Applicant(s) <b>Creighton</b>
Examiner <b>Lincoln Donovan</b>	Art Unit <b>2832</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Dec 12, 2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1, 2, 5, 6, 9, 10, and 31-51 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1, 2, 5, 6, 9, 10, and 31-51 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2

6)  Other:

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 1-2, 5-6, 9-10 and 31-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 5, applicant must clarify the specific structure to optimize the magnetic field. Applicant should clarify what is intended by “a desired magnetic field property” and “a selected point.”

Regarding claim 5, Applicant should clarify what is intended by “a desired magnetic field” and “a selected direction.”

Regarding claims 9-10, applicant should clarify the specifics of the medical procedure.

Regarding claims 31-32, applicant should clarify what direction is intended by “the desired magnetic field” and “a selected direction.” In lines 3-4, applicant should clarify what is intended by “a selected point.”

Regarding claim 33, lines 2-3, applicant should clarify the structure and/or arrangement to enable the magnetization to vary in three dimensions. In lines 3-4, applicant should clarify what is intended by “the selected point in the selected direction.”

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Regarding claim 34, applicant should clarify what surface is intended by “a surface of constant contribution.” Claim 34 depends upon itself. It is assumed that claim 34 is intended to depend upon claim 33.

Regarding claim 35, line 1, lines 2-3, applicant should clarify the structure and/or arrangement to enable the magnetization to vary in two dimensions. In lines 3-4, applicant should clarify what is intended by “a selected direction at a selected point.”

Regarding claim 36, applicant should clarify the structure and arrangement to enable the claimed contribution.

Regarding claim 37, applicant should clarify the “effective magnet center.” The specific structure to provide the maximum contribution.

Regarding claim 40, applicant should clarify what is meant by the magnetization property not being constant.

Regarding claim 41, applicant should clarify what is intended by “the selected point in the selected direction.”

Regarding claim 42, applicant should clarify the “surface of constant contribution.”

Regarding claim 43, applicant should clarify what is meant by the magnetization property being constant.

Regarding claim 44, applicant should clarify the “effective magnet center.” The specific structure to provide the maximum contribution.

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Regarding claim 45, applicant should clarify the “effective magnet center.” The specific structure to provide the maximum contribution.

Regarding claim 48, applicant should clarify how the magnetization direction is both constant and non constant.

Regarding claim 49, applicant should clarify the control of the magnetic field. It is unclear what is meant by “conforming to the surface of equal contribution.”

Regarding claim 50, applicant should clarify what is meant by “variable magnetization direction.”

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*Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 5-6 and 31-51, as best able to be understood in view of the rejections under 35 U.S.C. 112, second paragraph, are rejected under 35 U.S.C. 103(a) as being unpatentable over Leupold [US 5,216,400].

Leupold discloses a permanent magnet [19] having varying magnetic directions in three dimensions at selected points [see figure 2] with multiple embodiments and magnetic fields. The

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specific magnetization directions and orientations of the magnet segments would have been an obvious design consideration based on the desired magnetic field to be produced.

4. Claims 9-10, as best able to be understood in view of the rejections under 35 U.S.C. 112, second paragraph, are rejected under 35 U.S.C. 103(a) as being unpatentable over Leupold as applied to claims 1 and 5 above, and further in view of Golden et al. [US 5,622,169].

Golden et al. discloses a magnetic member used within the body of a patient.

Leupold discloses a permanent magnet providing multidimensional magnetic fields.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the permanent magnet of Leupold for the magnet of Golden et al. for the purpose of providing multidimensional control.

### *Conclusion*

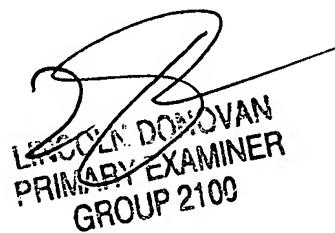
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lincoln Donovan whose telephone number is (703) 308-3111.

The fax number for this Group is (703)308-7724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0956.

LDD

February 21, 2003



LINEAR DONOVAN  
PRIMARY EXAMINER  
GROUP 2100